

II. REMARKS

Applicant offers the following remarks in response to the Office Action dated June 25, 2009.

A. STATUS SUMMARY

Claims 1-32 are pending in the present application. No claims have been added or cancelled. Accordingly, claims 1-32 remain pending.

In this Amendment, Applicant has amended claims 1, 5, 10, 11, 13, 16, 20, 24, 25 and 29-31. Applicant is not conceding that the subject matter encompassed by claims 1, 5, 10, 11, 13, 16, 20, 24, 25 and 29-31 prior to this Amendment is not patentable over the art cited by the Examiner. Claims 1, 5, 10, 11, 13, 16, 20, 24, 25 and 29-31 were amended solely for antecedent basis and to facilitate expeditious prosecution of the present application. Applicant respectfully reserves the right to pursue claims, including the subject matter encompassed by claims 1, 5, 10, 11, 13, 16, 20, 24, 25 and 29-31 as presented prior to this Amendment and additional claims in one or more continuing applications.

B. CLAIM OBJECTION

Claim 24 was objected to due to informalities. Claim 24 has been amended to add a period at the end of the sentence. Therefore, Applicant respectfully requests that the objection be withdrawn.

C. CLAIM REJECTIONS – 35 U.S.C. § 103

Claims 1-3, 5-11, 13-18, 20-23, 25-27, and 29-32 were rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over U.S. Patent Application Publication No. 2003/0023661 to

Clohessy et al. (hereinafter “Clohessy”) in view of U.S. Patent No. 6,493,871 to McGuire et al. (hereinafter “McGuire”). Applicant respectfully traverses.

For the Patent Office to combine references in an obviousness rejection, the Patent Office must first establish *prima facie* obviousness by showing where each and every element is taught or suggested in the combined references. MPEP § 2143.03. This is a fundamental to an analysis under the factual inquiries required by *Graham v. John Deere*, 383 U.S. 1 (Supreme Court, 1966), as a part of identification of the scope and content of the prior art. The Patent Office has failed to do so in the present rejection. At least one element is missing from the combination of references and the Patent Office has failed to provide any articulated reasoning as to why one of ordinary skill in the art would find the claims as a whole to be obvious in the absence of the claim features not present in the prior art. (See *In re Kahn*, 441 F.3d 977, 988 (CAFC, 2006), as explicitly endorsed by the Supreme Court). Such an analysis is required in order to satisfy the factual inquiry ascertaining the differences between the prior art and the claims at issue. Accordingly, the Patent Office has failed to establish *prima facie* obviousness and the present rejection should be withdrawn.

Independent claims 1, 10, 16, and 25 have each been amended for clarity and to expedite prosecution of the present application. Claims 1, 10, 16, and 25 have each been amended to recite, using the language of claim 1 for convenience, among other things, a variation of “substituting, upon determining that the list of the prerequisites that are not currently present on the client device would require more client device resources than the current resources of the client device, at least one other OSGi bundle that operates within the resource limitations of the

client device for one of the OSGi bundle and one of the prerequisites of the list of the prerequisites that are not currently present on the client device.” (emphasis added).

Support for the claim amendments may be found, for example, within the Specification at paragraph 0027. As such, no new matter is believed added by the present amendments.

Applicant respectfully submits that independent claims 1, 10, 16, and 25 are patentable over the references of record as cited, at least because the cited combination of references does not disclose Applicant’s claimed subject matter as quoted above.

Applicant provides the discussion below relative to the claim language prior to the amendments discussed above to further assist the Patent Office in determining that the present claims are patentable over the cited combination of references. Applicant respectfully submits that the Patent Office has erred in forming the present rejection and that multiple elements are missing from the cited combination of references. Further, the alleged rationale for arriving at Applicant’s claims does not effectively fill the gaps between Applicant’s claimed subject matter and the actual disclosure of the cited combination of references.

As a preliminary matter, independent claims 1, 10, 16, and 25 each recite, using the language of claim 1 for convenience, among other things, a variation of “determining, on a server, prerequisites for an OSGi bundle to be loaded on a client device, the prerequisites comprising a set of all OSGi bundles that are necessary for utilizing the OSGi bundle” (emphasis added). The McGuire reference discloses that a setup program is downloaded from the server along with a list of files required for installation of a software product on the client computer. (McGuire Summary). The McGuire reference also discloses that the setup program

running on a client determines whether some current or earlier version of files required for installation already exists on client computer and compiles a download request with a list of files needed. *Id.* The Patent Office has admitted that the files of McGuire are distinct from Applicant's claimed OSGi bundles. (Office Action dated June 25, 2009, pages 4 and 5). As such, current or earlier versions of files required for installation that may exist on client computer, though distinct from Applicant's claimed OSGi bundles as admitted by the Patent Office, are actually determined on the client device within the McGuire reference and not on a server.

The Patent Office's attempt to combine this functionality of the McGuire reference with the functionality of Clohessy, where it is disclosed that a server may identify one or more application components required to upgrade/update a client application (Clohessy, para. 0038-0039, emphasis added), destroys the functionality of the McGuire reference and renders it unsatisfactory for its intended purpose. It would further change a principle of operation of the McGuire reference to combine the two references.

The Patent Office is respectfully reminded that "[i]f [a] proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification." (MPEP § 2143.01, V citing *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984), emphasis added). Further, if the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. (MPEP § 2143.01, VI citing *In re Ratti*, 270 F.2d 810,

123 USPQ 349 (CCPA 1959)).

As such, for at least these reasons the McGuire reference cannot be combined with the Clohessy reference as alleged. Additionally, the Patent Office has erred in attempting to combine the McGuire reference with the Clohessy reference. Accordingly, the actual disclosure of the references is not sufficient to render the claims *prima facie* obvious, and the present rejection should be withdrawn for at least this additional reason.

As discussed above, independent claims 1, 10, 16, and 25 each recite, using the language of claim 1 for convenience, among other things, a variation of “determining, on a server, prerequisites for an OSGi bundle to be loaded on a client device, the prerequisites comprising a set of all OSGi bundles that are necessary for utilizing the OSGi bundle” The Patent Office admits that the Clohessy reference is limited to determining runtime resources needed on the client device to run an application component. (Office Action dated June 25, 2009, page 3). The Patent Office further admits that the Clohessy reference does not disclose “determining, on a server, prerequisites to be loaded on a client device, the prerequisites comprising a set of all (sic) that are necessary for utilizing the” software to be loaded. (*Id.* at page 4).

The Patent Office then also admits that the McGuire reference is limited to determining a list of files required to install a software package that a client has requested. *Id.* As such, the Patent Office has admitted that it has not identified the claimed “determining, on a server, prerequisites for an OSGi bundle to be loaded on a client device, the prerequisites comprising a set of all OSGi bundles that are necessary for utilizing the OSGi bundle” within the cited combination of references.

The Patent Office then attempts to fill the gap between Applicant's claimed subject matter and the actual disclosure of the cited references without citation to these claimed elements within any reference. The Patent Office alleges that it would be obvious to one of ordinary skill in the art to combine the cited references to arrive at Applicant's claimed subject matter in the absence of the claimed elements within the cited references. (*Id.* at page 5).

However, without identifying the claimed "determining, on a server, prerequisites for an OSGi bundle to be loaded on a client device, the prerequisites comprising a set of all OSGi bundles that are necessary for utilizing the OSGi bundle" within the cited combination of references, the Patent Office does not have two references that disclose all of the elements of Applicant's claims that may be properly combined. As such, the Patent Office does not have two references that are suitable for combination or that may be combined to actually arrive at Applicant's claims.

Accordingly, the Patent Office has erred in forming the present rejection and the cited rationale does not effectively fill the gaps between Applicant's claimed subject matter and the actual disclosure of the cited combination of references, and the present rejection should be withdrawn for at least this additional reason.

Additionally, the Patent Office has not provided sufficient articulated reasoning as to why a person of ordinary skill in the art would find the claims as a whole obvious in the absence of the claim features not present in the cited combination of references. The Patent Office is respectfully referred to MPEP § 2143 for examples of sufficient rationales, none of which appears to have been properly employed within the present Office Action.

Further, given the lack of disclosure within the cited references as discussed above, Applicant respectfully submits that the Patent Office may have only arrived at the present rejection through the use of improper hindsight reconstruction. The Patent Office is respectfully reminded that “[i]t is impermissible to use the claimed invention as an instruction manual or ‘template’ to pieced [sic] together the teachings of the prior art so that the claimed invention is rendered obvious ‘one cannot use a hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.’ ” *In Re Fritch*, 972 F.2d 1260, 1266 (Fed. Cir. 1992), citing *In re Gorman*, 933 F.2d 982, 987 and quoting *In re Fine*, 837 F.2d at 1075.

Within the Office Action dated June 25, 2009, the Patent Office appears to have made certain conclusory statements and engaged in impermissible hindsight reconstruction to pick and choose isolated disclosures to form the present rejections and has used Applicant’s Specification to fill gaps in the actual disclosure of the cited combination of references. However, Applicant respectfully submits that even with these conclusory statements and impermissible hindsight reconstruction, the Patent Office still has not met its burden of establishing *prima facie* obviousness of Applicant’s claims. Applicant respectfully requests reconsideration of the present rejection based further upon the previous discussion in addition to the claim amendments discussed above.

Based upon the analysis above, the Office Action dated June 25, 2009, fails to identify multiple elements of independent claims 1, 10, 16, and 25 within the combination of the cited references. Additionally, the Office Action alleges multiple factual errors regarding the

disclosure of the cited references as cited. The cited references may not be properly combined without rendering at least the McGuire reference unsatisfactory for its intended purpose and without changing a principle of operation of the McGuire reference. The Patent Office has not provided sufficient reasoning to fill the gaps between the actual disclosure of the cited references and Applicant's claimed subject matter. The Patent Office has further engaged in improper hindsight reconstruction to arrive at the present rejections by using Applicant's disclosure to fill the gaps in the disclosure of the cited references. Applicant respectfully submits that the Patent Office's legal conclusion of obviousness is also in error as at least being based upon erroneous factual allegations. Accordingly, the Patent Office has failed to establish a *prima facie* case of obviousness and the rejection of independent claims 1, 10, 16, and 25 should be withdrawn for at least this reason. Applicant reserves the right to provide additional arguments against the combination of the Clohessy reference with the McGuire reference in the future if needed.

Claims 2-3 and 5-9 depend from claim 1. Claims 11 and 13-15 depend from claim 10. Claims 17-18 and 20-23 depend from claim 16. Claims 26-27 and 29-32 depend from claim 25. Accordingly, the rejection of claims 2-3, 5-9, 11, 13-15, 17-18, 20-23, 26-27, and 29-32 should be withdrawn for at least the same reasons as the independent claims from which they depend. Applicant respectfully submits that claims 1-3, 5-11, 13-18, 20-23, 25-27, and 29-32 are in condition for allowance and notice of the same is requested at the earliest possible date.

Claims 4, 12, 19, and 28 were rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Clohessy in view of U.S. Patent Application Publication No. 2003/0131226 to Spencer et al. (hereinafter "Spencer"). Claim 24 was rejected under 35 U.S.C. § 103(a) as being

allegedly unpatentable over Clohessy, in view of McGuire, and further in view of U.S. Patent Application Publication No. 2005/0004974 to Sharma et al. (hereinafter “Sharma”). Applicant respectfully traverses.

The standards for establishing a *prima facie* case of obviousness have been set forth above. The Patent Office has not established a *prima facie* obviousness and the present rejection should be withdrawn.

Claim 4 depends indirectly from claim 1. Claim 12 depends indirectly from claim 10. Claims 19 and 24 depend, either directly or indirectly, from claim 16. Claim 28 depends indirectly from claim 25. Accordingly, the rejection of claims 4, 12, 19, 24, and 28 should be withdrawn for at least the same reasons as the independent claims from which they depend. Additionally, the Patent Office has not alleged that the Spencer reference cures the deficiencies discussed above with respect to the Clohessy reference and the Patent Office has not alleged that the Sharma reference cures the deficiencies discussed above with respect to the combination of the Clohessy and McGuire references. Further, the Patent Office has not provided any articulated reasoning as to why a person of ordinary skill in the art would find the claims as a whole obvious in the absence of the claim features not present in the cited combination of references. Accordingly, for at least these additional reasons the rejection of claims 4, 12, 19, 24, and 28 should be withdrawn. Applicant reserves the right to provide additional arguments against the combination of the Clohessy reference with the McGuire, Spencer, and Sharma references in the future if needed. Applicant respectfully submits that claims 4, 12, 19, 24, and 28 are in condition for allowance and notice of the same is requested at the earliest possible date.

The undersigned additionally notes that many distinctions exist between the cited references and the claims. However, in view of the deficiencies discussed above, further discussion is believed to be unnecessary at this time. Failure to address each point raised in the Office Action should accordingly not be viewed as accession to the Examiner's position or an admission of any sort.

Applicant respectfully submits that claims 1-32 are in condition for allowance and notice of the same is requested at the earliest possible date. Applicant reserves the right to provide additional arguments against the rejection of these claims in the future if needed. In view of the above, reconsideration and allowance are respectfully requested.

III. CONCLUSION

In light of the above Amendments and Remarks, it is respectfully submitted that the present application is now in proper condition for allowance, and an early notice to such effect is earnestly solicited.

If any small matter should remain outstanding after the Patent Examiner has had an opportunity to review the above Remarks, the Patent Examiner is respectfully requested to telephone the undersigned patent attorney in order to resolve these matters and avoid the issuance of another Office Action.

Although it is believed that no fees are due, the Commissioner is hereby authorized to charge any additional fees which may be required, or credit any overpayment, to Deposit Account No. 09-0461.

Respectfully submitted,

Lee Law, PLLC

Date: September 23, 2009

By: /Christopher B. Lee/
Christopher B. Lee, Reg. No. 58793
Lee Law, PLLC
P.O. Box 189
Pittsboro, NC 27312
Phone: (919) 542-1956
Fax: (919) 542-5125
chrislee@leelawpllc.com

Customer No. **75532**